Remarks / Arguments

Claims 1-11, and 13-14 are pending in this application. Claims 1-11, 13 and 14 stand rejected. By this amendment, Claims 10-11 are cancelled and claim 1 is amended.

Entry of this amendment is appropriate since the amendments in conjunction with the following discussion (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issues requiring further search and/or consideration; (c) do not present any additional claims and (d) place the application in better form for appeal- should such appeal be necessary. Entry of the amendments is therefore respectfully requested.

Accordingly, the applicants believe that all the claims present in this application are allowable. If however, there remain are any unresolved issues requiring adverse action in any of the claims now pending in this application, it is requested that the Examiner telephone Jeffery J. Brosemer, Ph.D., ESQ. at 732-335-5773 so that arrangements may be made for resolving such issues as expeditiously as possible.

Claim Rejections -35 U.S.C. §103

Claims 1-11, 13 and 14 are rejected under the provisions of 35 U.S.C. §103(a) as being unpatentable over Inoue (United States Patent No. 6510153) in view of Rai (United States Patent No. 6421714).

As amended, claim 1 is directed to a method of configuring a mobile host when the mobile host powers up without a permanent home address in a foreign network. In particular, the method includes the steps of acquiring a temporary IP address, wherein the temporary IP address is allocated by a bootstrapping agent associated with a home agent of the mobile host's home network, upon receiving the temporary IP address, establishing a temporary tunnel between a foreign agent and the home agent, and communicating configuration information including the permanent home address, from a DHCP server in the home network, such that the mobile host connects to the Internet.

In the Office Action, the Examiner correctly identified one significant difference between the claimed method and the method disclosed in the Inoue patent, namely that the

Inoue patent does not teach using a temporary home address to create <u>a temporary tunnel</u> between foreign agents associated with the host and the M-IP home agent, wherein the <u>temporary tunnel</u> is used to communicate configuration information including a permanent home address allocated.

Recognizing this teaching deficiency in the Inoue patent, the Examiner now relies on the Rai patent in an attempt to cure this deficiency. More particularly, the Examiner states that Rai teaches (col.25 lines 55 – col 26 lines 16) in a foreign network creating a temporary tunnel for communicating data such as dynamic address allocation.

As the applicants will show however, Rai <u>does not</u> teach or suggest this important aspect of the present invention as recited in independent claim 1.

Referring now to the Rai patent, and in particular to the cited columns noted by the Examiner, it is urged that while the Rai patentees do generally disclose certain aspects of tunneling protocols and in particular known L2TP and their "new" tunneling protocol based upon L2TP namely xtunnel, they <u>do not</u> teach or suggest the <u>temporary</u> or <u>transient</u> tunnels which are now explicitly claimed. Instead, the tunnels described in Rai are permanent.

With continued reference to that Rai patent – and in particular FIG 19, it is noted that this figure shows the protocol stacks for a roaming end system. Of particular interest to the claimed invention, as depicted in this FIG 19 the serving IWF uses the I-xtunnel protocol between the serving IWF and home IWF.

Importantly, the new xtunnel protocol is based upon the known L2TP. As described by the patentees, therein, these tunnels remain up throughout the entire PPP session. (Cols 21-22, Lines 10 – 60). Accordingly, and as explicitly noted by the patentees, <u>there are no transient tunnels employed in the Rai patent</u> – and there certainly are none which are used to further establish permanent tunnels. Since the tunnels taught and described in the Rai patent are of the known, permanent variety, the applicants submit that the patentees actually <u>teach away</u> from the present invention.

At this point, the differences between the two-staged claimed invention and the combination of references as cited by the Examiner is apparent. The present invention employs a bootstrapping agent to create a temporary tunnel over which standard DHCP transactions can take place. After the temporary tunnel is used to establish the DHCP parameters and permanent home address – a subsequent, permanent tunnel may be used to effect the transmission of subsequent user data.

Of further importance, it is again noted that the Inoue patent discloses the mobile communication scheme which uses dynamic address allocation wherein a temporary address is allocated such that the mobile host connects to the DHCP server in a home network <u>using the temporary address as the home address.</u> (Inoue, Col. 16 – lines 4-12).

In sharp contrast, and according to the claimed invention of the instant application,, the temporary address is only used to establish a temporary (transient) tunnel between the home agent and the foreign agent. It is not used as the home address as explicitly taught and described by the Inoue patent.

Accordingly, if one were to combine the two references in the manner described by the Examiner, the temporary address would be used as the home address – which is contrary to the claimed invention. Consequently, the applicants submit that the cited combination of references simply could not work as does the claimed invention of the instant application.

Therefore, the cited combination of Inoue patent in view of the Rai patent does not render amended claim 1 unpatentable. Since independent claims 9, 13 and 14 each recites substantially similar limitations, the cited combination of the Inoue patent in view of the Rai patent does not render these amended claims as unpatentable as well.

Inasmuch as the dependent claims 2-8 each depend from, and further distinguish amended claim 1, respectively, the cited combination of the Inoue patent and the Rai patent does not render these claims unpatentable as well.

The applicants respectfully request the Examiner to withdraw the rejections under the provisions of 35 U.S.C. §103(a).

Conclusion:

The applicants submit that the claims now present in the application are in compliance with the provisions of 35 U.S.C. §103, and are therefore patentable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

Respectfully submitted,
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CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office on 1/19/2009.

s/Jeffery J. Brosemer/

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